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OFFICE OF PETITIONS

In re Application of :
Handa, et al. :
Application No. 10/664,036 : DECISION
Filing Date: 17 September, 2003 :
Attorney Docket No.: 123776 :

This is a decision on the petition filed on 12 December, 2007, to revive an application under 37 C.F.R. §1.137(b) as having been abandoned due to unintentional delay.

The Office regrets the delay in addressing this matter, however, the instant petition was presented to the attorneys in the Office of Petitions only at this writing.

The petition under 37 C.F.R. §1.137(b) is **GRANTED**.

As to the Allegations
of Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee. (However, it does not appear that a terminal disclaimer and fee are due here.)

It appears that Petitioner has satisfied the requirements of the regulation, as set forth below:

BACKGROUND

The record reflects that:

Application No.: 10/664,036

Applicant failed to reply timely and properly to the non-final Office action—copy enclosed—mailed on 4 April, 2005, with reply due absent and extension of time on or before Tuesday, 5 July, 2005.

The instant application went abandoned by operation of law after midnight 4 July, 2005.

It does not appear that the Office mailed a Notice of Abandonment before the original petition was filed.

On 14 December, 2005, Petitioner filed the original petition, seeking relief under 37 C.F.R. §1.181 averring non-receipt of the Office action in question and alleging that Office records reflect that the Office action in question could not have been received because it was returned to the Office by the US Postal Service (USPS) as undelivered;

Although the application went abandoned by operation of law after midnight 4 July, 2005, no action was taken by anyone herein to seek relief under 37 C.F.R. §1.181 until more than five (5) months after abandonment—at which time Petitioner averred and acknowledged that he was not the Counsel of record at the time the application went abandoned, and—in fact—he did not file of record a Revocation/Power of Attorney empowering him executed on 11 May, 2005, until 27 May, 2005.

Because the record is clear that, *inter alia*, the Office action in question was mailed to the address of record and that Applicant's former Counsel changed address without advance Notice to the Office as is required, and that burden falls to the Applicants and their now-Counsel, the Petitioner herein—and so the petition was dismissed on 17 August, 2006;

The Office mailed the Notice of Abandonment on 3 October, 2006.

On 2 October, 2006, Petitioner filed a second petition, with fee, reply in the form of an amendment (previously filed) and made a statement of unintentional delay—however, again, Petitioner was not of record at the time the application went abandoned and could not make the statement as to the nature of the delay herein—a statement that appears only can be made by former Counsel, Applicant and/or Assignee of record—the petition was dismissed on 9 October, 2007.

On 12 December, 2007, Petitioner filed the instant petition (with fee) with supporting statement from former Counsel in support of the allegation of unintentional delay under 37 C.F.R. §1.137(b), included therewith, *inter alia*, a reply in the form of an argument/remarks submitted on 2 October, 2006, and made the statement of unintentional delay.

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an

applicant/practitioner on-demand information as to events/transactions in an application. Thus, now if one wishes to know the progress in and/or status of an application or the accuracy of the data therein, one need only look at the file online.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice *and* all others who make representations before the Office must inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.¹

STATUTES, REGULATIONS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a Petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application.^{2,3}

CONCLUSION

The instant petition under 37 C.F.R. §1.137(b) is granted.

The instant application is released to Technology Center/AU 2879 for further processing in due course.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the instant decision to ensure that the revival has been acknowledged by the Technology Center/AU in response to this decision. It is noted that all inquiries with regard to any failure of that change in status should be directed to the Technology Center/AU OPAP where that change of status must be effected—that does not occur in the Office of Petitions.

¹ See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office). See specifically, the regulations at 37 C.F.R. §10.18.

² See: Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

³ The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition. (Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.) Delays in responding properly raise the question whether delays are unavoidable. Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a). And the Petitioner must be diligent in attending to the matter. Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care. (By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.))

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2⁴) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).



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Office of Petitions

⁴ The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.